

SUPPORT FOR THE AMENDMENTS

Claims 1-7 and 10 are herein canceled. Applicants make no statement regarding the propriety of the rejections of these claims and preserve the right to submit these claims in a continuation application without prejudice.

Claims 8 and 9 are herein canceled. The description of Claim 8 is included in new Claim 13.

Claim 13 is new and is supported by Claims 3 and 8, on page 3, lines 1-6, and on page 5, lines 7-19, in the specification.

Claim 11 is amended to depend from Claim 13 and to use wording and structure consistent with U.S. patent law practice.

Claim 14 is new and is supported by Claim 4 and on page 3, lines 1-6, in the specification.

Claim 12 is amended to depend from Claim 14 and to use wording and structure consistent with U.S. patent law practice.

Claim 15 is new and is supported on page 5, lines 16-22, in the specification.

Claim 16 is new and is supported on page 5, lines 24-28, in the specification.

No new matter is believed added to this application by entry of this amendment.

Upon entry of this amendment, Claims 11- 16 are active.

REMARKS/ARGUMENTS

The claimed invention is directed to a container for dispensing a fluid composition and a method to prepare the container charged with the fluid composition. A fluid dispensing container which is simple in production, does not employ a propellant, yet provides the dispensing performance of an aerosol system is sought.

The claimed invention addresses this problem by providing the fluid dispensing container described in Claim 13 and claims dependent thereon, and a method for preparing the fluid dispensing container according to Claim 14 and claims dependent thereon. No such container is disclosed or suggested in the cited references.

Applicants have described that pumps suitable for use on the claimed sealed container are described in, for example, U.S. 4,511,069 (Page 3, lines 10-13). Applicants respectfully submit that in the described pump systems, the fluid to be dispensed is located in a sealed chamber and the chamber is connected through a tube and valve to a discharge chamber. The sealed chamber containing the fluid to be dispensed is pressured such that when the pressure of the discharge chamber is low, fluid moves through the tube and valve from the sealed chamber to the discharge chamber. When the discharge chamber is full, the valve to the sealed chamber is closed. An external actuator is then depressed which exerts a pressure increase on only the discharge chamber and when the pressure exerted is sufficient a second valve leading to the outside of the device is forced open and the fluid is dispensed. The external valve to the empty discharge chamber closes and due to a pressure drop in the discharge chamber, fluid again enters from the sealed container.

Applicants further note that a propellant gas can be defined as a compressed inert gas, such as a fluorocarbon, that acts as a vehicle for discharging the contents of an aerosol container (The Free Dictionary by Farlex).

Typically propellants are charged to the sealed container to provide the pressure necessary to move the fluid from the sealed chamber to the discharge chamber. Applicants have described the drawbacks of the use of propellant gases on page 2, lines 21 to 32, in the specification.

According to the claimed invention, the pressure necessary to move the fluid from the sealed chamber is provided by a low-boiling liquid in the sealed container and no propellant gases are used.

Applicants wish to thank Examiner Nguyen and Supervisory Examiner Pyon for the useful and courteous discussion of this application with Applicants' U.S. representative on March 10, 2009. At that time, Applicants' U.S. representative presented and discussed possible amendments to the claims. He then reviewed the descriptions of the cited references and contrasted the descriptions of these references against the invention as described in the proposed amended claims. The following reiterates and expands upon that discussion.

Applicants respectfully note that Claims 1, 2 and claims dependent thereon are herein canceled. Claims 3 and 4 are canceled and rewritten as Claims 13 and 14 which describe a fluid dispensing container and a method to prepare the fluid dispensing container. The following remarks describe why Claims 13 and 14 and claims dependent thereon, are not anticipated or rendered obvious by the cited references.

The rejection of Claims 1-12 under 35 U.S.C. 102(b)Yazawa et al. (GB 1,537,436) is respectfully traversed.

Yazawa describes an airtight vessel which is pressurized with a gas (Claim 1). All the examples in Table 1 describe a pressurized air-tight vessel containing from 2.0 to 15.0 % by weight of a pressurized gas. Applicants respectfully submit that nowhere does this reference disclose or suggest a fluid dispensing container where the container is not pressured with a gas. The reference actually states (page 4, lines 23 to 31) the importance of pressurizing the container as follows:

(2) Since the air-tight vessel is employed, a volatile content can be filled, and the spraying device can be used in the same manner as an aerosol-type spraying device and a similar effect or condition can be attained.

(3) Spraying is accomplished by the synergistic action of the mechanical pressurization of the piston and the pressure of the content per se.

In contrast, the presently claimed invention describes a fluid dispensing container as described above. The contents are added to the container as a liquid and no gas pressurization is employed. After the liquid mixture (low-boiling liquid and fluid to be dispensed) is placed in the container, the pump is mounted and sealed without any pressurization by adding a propellant. The advantages of the claimed invention include: 1) risk of fluid leakage is avoided; and 2) charging the container is a simple operation.

Applicants respectfully call the Examiner's attention to *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) which states:

“[R]ejections under 35 U.S.C. 102 are proper only when the claimed subject matter is identically disclosed or described in “the prior art.” Thus for the instant rejection under 35 U.S.C. [102(b)] to have been proper, the . . . reference must clearly and unequivocally disclose the claimed [subject matter] or direct those skilled in the art to the [subject matter] . . .”

In view of the foregoing, Applicants respectfully submit that the cited reference does not meet the Arkley test and therefore cannot anticipate the claimed invention. Moreover, as the cited reference actually teaches that a pressurized gas is required as indicated above, Applicants respectfully submit that this reference cannot render the claimed invention obvious. Accordingly, withdrawal of the rejection of Claims 1-12 under 35 U.S.C. 102(b) Yazawa is respectfully requested.

The rejections of Claims 1, 2, 5, 6, 7 and 10 under 35 U.S.C. 102(b) over Chan et al. (U.S. 5,804,166), Watling et al. (U.S. 5,206,009) or Nuber et al. (U.S. 4,767,613) is moot in view of the cancellation of these claims herein.

Each of the cited references describes a hair spray composition. None of these cited references describe a fluid dispensing container, method to prepare the container or method to

dispense a fluid according to the claimed invention. In view of the cancellation of Claims 1, 2, 5, 6, 7 and 10, herein, withdrawal of the rejection is respectfully requested.

The rejection of Claims 3, 4, 8, 9, 11 and 12 under 35 U.S.C. 103(a) over Yazawa and in view of Chan, Watling or Nuber is respectfully traversed.

The deficiencies of the primary reference are described above. Specifically Yazawa requires the use of propellant pressurized gas. None of the cited references describes, suggests or provides motivation that would have led one of ordinary skill in the art, at the time of the invention, to derive the fluid dispensing container of the claimed invention where no pressurized gas is charged to the container.

Chan describes the use of propellants (Col. 3, lines 40-52) and lists many of the same propellants described by the primary reference.

Watling describes a conventional non-aerosol pump hair spray (Col. 1, line 27). As Applicants have explained (page 1, lines 11-35), such non aerosol compositions are intended to be used with non air-tight (not sealed) containers, where air can enter from outside the container to compensate for the volume of the product dispensed. The entering air thereby prevents the formation of a vacuum in the void of the dispensed liquid. No where does this reference disclose or describe a sealed container according to the claimed invention.

Applicants further submit that the composition described by Watling could not be properly dispensed from a sealed container. The high water content and the fact that the low boiling liquids in the proportions described are completely miscible with water results in a mixture which would provide insufficient vapor pressure to compensate the void of the dispensed liquid.

Applicants point to Example 3 of the present invention as describing a hair spray composition according to the claimed invention. In this composition of the invention, in

comparison to the Watling composition, higher amounts of low boiling liquids are present. In addition, water insoluble isopentane is the low boiling liquid.

Applicants respectfully submit that Watling does not disclose or suggest a sealed container and the compositions of the reference are unsuitable for use in a sealed dispensing container. Moreover, Watling addresses a different problem (hair spray with reduced drying time) than that of the present invention. Therefore, Watling cannot provide any motivation that would have led one of ordinary skill in the art at the time of the invention to eliminate the propellant of Yazawa. Moreover, such action if taken, would be contrary to the Yazawa mode of action.

Nuber describes a propellant employed in a hair spray composition (Col. 2, lines 65-69). Applicants note that this secondary reference lists isopentane as a propellant. However, Applicants respectfully note that it is known to one of ordinary skill in the art, that due to its low volatility, isopentane is not suitable as a single propellant component, and can only be used in a mixture with a lighter compound. Applicants note the examples shown in Tables 1, 2 and in Example 13 all employ a propane/butane mixture. Accordingly, this secondary reference, at the time of the invention, would have provided no motivation to one of ordinary skill in the art to remove the propellant required by Yazawa.

Applicants respectfully call the Examiner's attention to the following excerpt from the Office's own discussion of "**Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.***"

"The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention.<sup>43</sup> "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the

claimed new invention does.”<sup>44</sup> **If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art,”**  
(Federal Register, Vol. 72, No. 195, page 57529) **(Bold added)**

Moreover, in a Precedential Opinion rendered by the Board of Patent Appeals and Interferences in *Ex parte* Whalen II (Appeal 2007-4423, Application 10/281,142) on July 23, 2008, the Board stated:

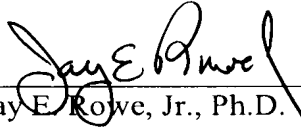
“The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “apparent reason to combine the known elements in the fashion claimed.””

In view of all the above, Applicants respectfully submit that none of the cited secondary references disclose, suggest or provide motivation that would have led one of ordinary skill in the art, at the time of invention to modify the primary reference, contrary to the teaching of that reference, and derive the claimed invention. Accordingly, the cited combination of references cannot render the claimed invention obvious and withdrawal of the rejection of Claims 3, 4, 8, 9, 11 and 12 under 35 U.S.C. 103(a) over Yazawa and in view of Chan, Watling or Nuber is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for allowance and early notice of such action is earnestly solicited.

Respectfully submitted,

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